Malhotra International Private ... vs Rohan Malhotra And Ors on 13 November, 2026

Author: Debangsu Basak

Bench: Debangsu Basak

2026:CHC-OS:458-DB

OCD-1

IN THE HIGH COURT AT CALCUTTA
COMMERCIAL APPELLATE DIVISION
ORIGINAL SIDE

TEMPAPO-IPD/7/2026
IA NO: GA-COM/1/2026

MALHOTRA INTERNATIONAL PRIVATE LIMITED
VS
ROHAN MALHOTRA AND ORS.

BEFORE:
The Hon'ble JUSTICE DEBANGSU BASAK
-AND-
The Hon'ble JUSTICE AJAY KUMAR GUPTA

For the Appellant : Mr. Debnath Ghosh, Sr. Adv.
Mr. Biswaroop Mukherjee, Adv.
Mr. Vishwarup Acharyya, Adv.

For Respondent No. 3 : Mr. Sayantan Roy Chowdhury, Adv.

Mr. Tanmoy Roy, Adv.

Ms. Sohini Mukherjee, Adv.

For I.L.S : Mr. Jaydip Kar, Sr. Adv.
Mr. K. Mondal, Adv.
Mr. A. Pramanick, Adv.

HEARD ON : 13.11.2026
DELIVERED ON : 13.11.2026

DEBANGSU BASAK, J.:-

1. Appeal is at the behest of the plaintiff in a suit for infringement and passing off and directed against the order dated October 14, 2026 passed in TEMPAPO-IPD 7/2026.

2. By the impugned order, learned Single Judge did not dispense with pre-institution mediation under Section 12A of the 2 2026:CHC-OS:458-DB Commercial Courts Act, 2015. Learned Single Judge directed return of the plaint along with the Court

fees to the appellant. Learned Single Judge also consequently, did not consider the prayer for leave under Clause 14 of the Letters Patent, 1865 and Order II Rule 2 of the Code of Civil Procedure, 1908. Learned Single Judge directed the suit to be de-registered from the database of the High Court.

3. Learned Senior Advocate appearing for the appellant submits that, the respondents are guilty of infringement and passing off. He refers to the products of the appellant as well as of the respondents. He submits that, the appellant manufactures and sells shaving blades in the name and style of "PANAMA, since 1951. At the very least, the appellant is in such business since 1954, on the basis of the documents disclosed. He submits that, the respondents commenced marketing of shaving blades in the same name and style of "PANAMA" from the month of September, 2026. In this regard, he draws the attention of the Court to the averments made in the plaint at paragraph nos. 58 to 61.

4. Learned Senior Advocate appearing for the appellant submits that, the appellant possesses a registered trademark in respect of the word "PANAMA". He submits that, the respondents filed an application for rectification. Such rectification application is being contested on behalf of the appellant. Registrar is yet to take a final decision on the application for rectification. 3

5. Learned Senior Advocate appearing for the appellant submits that, during the pendency of the application for rectification, the appellant came across products manufactured and marketed by the respondents in the 2nd week of September, 2026. He draws the attention of the Court to the products of the respondents. He submits that, the respondents are using the same word "PANAMA" to market shaving blades. He submits that, the appellant made out a case both of infringement as also of passing off.

6. On the aspect of infringement, learned Senior Advocate appearing for the appellant submits that, till such time, the application for rectification is decided in favour of the respondents, the appellant can maintain a suit for infringement. That apart, on the aspect of passing off, he submits that, since, the appellant is a prior user, the respondents are guilty of marketing a product in the same name and style of "PANAMA" and therefore, are guilty of passing off.

7. Learned Senior Advocate appearing for the appellant submits that, the learned Single Judge, in the impugned order, noted that, although, the case for infringement is not made out so as to sustain a prayer for dispensation under Section 12A of the Act of 2015, nonetheless, there was an arguable case on account of passing off. He submits that, on both grounds, the learned Trial Judge, erred in holding so. He submits that, the appellant can sustain a suit and seek urgent interim relief on the basis of the claim for infringement as also of passing off. 4

8. Learned Senior Advocate appearing for the appellant submits that, the learned Single Judge did not apply the correct principles in assessing leave under Section 12A of the Act of 2015. He relies upon (2022) 10 SCC 1 (Patil Automation Private Limited Vs. Rakheja Engineers Private Limited) as well as 2023 SCC OnLine SC 1382 (Yamini Manohar Vs. T. K. D. Keerthi) in support of the proposition that, assessment of requirement to dispense with compliance under Section 12A of the Act of 2015 is on the basis of materials made available on record by the plaintiff in the plaint. On such assessment, the Court needs to arrive at a finding as to whether or not the plaintiff is entitled to dispensation under Section 12A of the Act of 2015. He submits that, both Patil Automation Private Limited (supra) as well as Yamini Manohar (supra) were considered by a later decision of the Hon'ble Supreme Court reported at (2025) 9 SCC 424 (Dhanbad Fuels Private Limited Vs. Union of India and Another).

9. Learned Senior Advocate appearing for the appellant relies upon (2026) 4 SCC 815 (Novenco Building and Industry A/S Vs. Xero Energy Engineering Solutions Private Limited and Another.) for the proposition that, the Court is to look into the plaint pleadings and supporting documents to decide where urgent interim relief is genuinely contemplated or not. He submits that, in the instant case, the learned Trial Judge erred in not applying the ratio laid down in Patil Automation Private Limited (supra,) Yamini Manohar (supra), Dhanbad Fuels Private Limited (supra) and Novenco 5 2026:CHC-OS:458-DB Building and Industry A/S (supra) so far as dispensation of leave under Section 12A of the Act of 2015 is concerned.

10. Learned Senior Advocate appearing for the appellant draws the attention of the Court to the decision of the Co-ordinate Bench dated October 12, 2026 passed in APDT/24/2026 (ITC Limited Vs. SMM Tobacco Private Limited and Ors.). He submits that, a Special Leave Petition directed against such decision is pending before the Hon'ble Supreme Court, where the Hon'ble Supreme Court was pleased to stay such decision by the order dated November 4, 2026 passed in Special Leave Petition to Appeal (C) No. 37908 of 2026 (ITC Limited Vs. SMM Tobacco Private Limited and Ors.).

11. Relying upon (2008) 10 SCC 419 (K. Narayanan and Another Vs. S. Murli), learned Senior Advocate appearing for the appellant submits that, contest of the rectification application, per se, did not give rise to a cause of action of infringement and passing off since, the appellant did not come across any product in the market manufactured and marketed by the respondents. The appellant came across such products only in the 2nd week of September, 2026. The suit was filed on October 9, 2026. He points out that, an application for injunction was made ready. However, the Department did not allow filing of the injunction petition simultaneously/together with the plaint.

12. Although, the respondents need not be heard at the stage where the present suit is lying, nonetheless, we extended the facility of hearing the respondents. We did so, in view of the fact that, there 6 2026:CHC-OS:458-DB is an Office Order dated January 20, 2026 issued by the Registrar- in-Charge, Original Side, High Court at Calcutta with regard to filing of interlocutory application simultaneously/together with the plaint. Such Office Order was passed on the basis of an order dated March 26, 2025 passed in CS No. 38 of 2025 in IA No. GA/1/2025 by a learned Single Judge and, on consideration of a representation dated February 7, 2025 submitted by the President, Incorporated Law Society, a wing of the Members of the Bar of the High Court at Calcutta.

13. Learned Advocate appearing for the respondents submits that, the respondents are manufacturing and selling the shaving blades in the name and style of "PANAMA" since January 20, 2026. According to him, the appellant as the plaintiff knew of such manufacture and sale. The plaint was filed in October, 2026. Therefore, there was a delay in filing the plaint. Consequently, the Court rightly rejected dispensation under Section 12A of the Act of 2015.

14. In course of hearing of the appeal, our attention was drawn to the order dated March 26, 2025 passed in CS No. 38 of 2025 in IA No. GA/1/2025 (Aditya Vikram Birla Vs. Parivesh Shukla and Anr.). By such order, a learned Single Judge, directed as follows:

> "9. In view of the above, the department is directed henceforth, unless the plaint is admitted or leave is taken from this Court for filing interlocutory application before the presentation of the plaint, the department is directed not to register any interlocutory application 7 2026:CHC-OS:458-DB without the presentation of the plaint or without the leave of this Court"

15. Department issued an Office Order dated January 20, 2026 containing inter alia, the following directions:-

> "By an order dated 26.03.2025, in CS 38 of 2025, IA No. GA 01 of 2025, The Hon'ble Justice Krishna Rao has been pleased to direct, inter alia, as follows:
>
> "...9. In view of the above, the department is directed henceforth, unless the plaint is admitted or leave is taken from this Court for filing interlocutory application before the presentation of the plaint, the department is directed not to register any interlocutory application without the presentation of the plaint or without the leave of this Court..."
>
> 4. Hence Central Filing Department is directed to comply with the above referred order of the Hon'ble Court.
>
> The Joint Registrar (Admin-I), Original Side and the Deputy Registrar (Court & Judicial), Original Side are also requested to ensure the compliance of the Office Order."

16. The Office Order dated January 20, 2026 was issued pursuant to the representation dated February 7, 2025 submitted by the President, Incorporated Law Society of the High Court at Calcutta.

17. In such conspectus, we requested the learned President, Incorporated Law Society, High Court at Calcutta to address us on the representation dated February 7, 2025 and the portion of the Office Order dated January 20, 2026 as noted above. Learned President of the Incorporated Law Society of High Court at Calcutta did so at our request.

18. In response to a query of the Court, learned President of the Incorporated Law Society, High Court at Calcutta submitted that, the representation dated February 7, 2025 was to the contrary of the ultimate direction issued in the Office Order. In this regard, he draws the attention of the Court to the representation dated February 7, 2025 and particularly to paragraph (vii) thereof. He submits that, the members of the Bar were facing difficulty in filing injunction petitions or any interlocutory application simultaneously/together with the filing of the plaint. He submits that, the Department was not accepting filing of interim applications along with the plaint which was inimical to the interest of the litigants and was not in the aid of justice.

He submits that, the direction contained in the Office Order dated January 20, 2026 following the order dated March 26, 2025 should be set aside. He submits that, the litigant should be allowed to file such application as they are entitled to file interim application simultaneously/together with the plaint. In the event, ultimately, if the plaint is not admitted, then, the interim applications will also, meet the fate of non-admission of the plaint.

19. Given the nature of the Office Order dated January 20, 2026, which followed the order dated March 26, 2025 passed in CS No. 38 of 2025 in IA No. GA/1/2025, we invited the opinion of the learned counsel for the respective parties. We also invited the learned Senior Advocate appearing for the plaintiff in CS No. 38 of 2025 to address us on the order dated March 26, 2025. 9

2026:CHC-OS:458-DB

20. At the Bar, the consensus was that, a litigant should be allowed to file an interim application simultaneously/together with the plaint. At the Bar, the consensus was that, the direction contained in the order dated March 26, 2025 passed in CS No. 38 of 2025 in IA No. GA/1/2025 and the Office Order dated January 20, 2026 created unnecessary fetters on the rights of a litigant to approach the Court. Therefore, the direction to that extent should be set aside. In fact, the Court should permit filing of interim applications simultaneously/together with the plaint. The Department should be directed to accept such filing subject, however, to the just objections which the Department may raise by way of a writing to be placed before the Court which is to consider such plaint and the application.

21. Considering such consensus of the members of the Bar as noted above and considering the fact that, a litigant is entitled to approach the Court, subject to just limitations, we deem it appropriate to set aside the directions contained in the Office Order dated January 20, 2026 as noted in paragraph 15. The Department will permit a litigant to file any interim application simultaneously/together with the filing of the plaint henceforth.

22. The portions of the Office Order dated January 20, 2026 as noted in paragraph 15, if allowed to stand in the manner and form as it stands today, is likely to defeat the request for urgent interim relief as also the grant thereof. In a given facts and circumstances of a case, a plaintiff may need to approach the Court 10 2026:CHC-OS:458-DB simultaneously/together with the plaint in order to seek that urgent interim relief.

23. Adverting to the merits of the matter in the present case, we are concerned presently with refusal to grant leave under Section 12A of the Act of 2015 and consequently, non-consideration of the prayer for leave under Clause 14 of the Letters Patent, 1865 and Order II Rule 2 of the Code of Civil Procedure, 1908.

24. There is no dispute that the subject matter of the disputes in the plaint falls within Section 2(1)(c) (xvii) of the Act of 2015. Suit is valued in excess of the Specified Value in terms of Section 7 of the Act of 2015. The suit was sought to be presented before the Commercial Division of this Hon'ble Court on October 14, 2026 with the plaint being filed on October 9, 2026. Sum and substance of the allegations of the appellant as the plaintiff is that, it is manufacturing and marketing shaving blades in the name and style of "PANAMA" since 1951. It possesses a registered trademark in respect of the word "PANAMA" since 1954. The appellant as the plaintiff came across products of the respondents which infringed the word mark and is in any event a passing off of the products of the appellants in the market in the 2nd week of September, 2026 whereupon, the appellant approached the Court for urgent interim relief in the suit for infringement and passing off.

25. Section 12A of the Act of 2015 is mandatory. Such is the view of the Hon'ble Supreme Court as appearing from Patil Automation Private Limited (supra,) Yamini Manohar (supra), Dhanbad Fuels 11 2026:CHC-OS:458-DB Private Limited (supra) and Novenco Building and Industry A/S (supra).

26. All of these decisions of the Hon'ble Supreme Court further noted that, in the event, a plaintiff makes out a case for grant of urgent interim relief then, the plaintiff need not be asked to undertake mandatory pre-institution mediation under Section 12A of the Act of 2015.

27. So far as dispensation of compliance with pre institution mediation under Section 12A of the Act of 2015 is concerned, Dhanbad Fuels Private Limited (supra) is of the following view:-

> "71.4. A suit which contemplates an urgent interim relief may be filed under the 2015 Act without first resorting to mediation as prescribed under Section 12-A of the 2015 Act.
>
> 71.5. Unlike Section 80(2)CPC, leave of the court is not required to be obtained before filing a suit without complying with Section 12-A of the 2015 Act. 71.6. The test for "urgent interim relief" is if on an examination of the nature and the subject-matter of the suit and the cause of action, the prayer of urgent interim relief by the plaintiff could be said to be contemplable when the matter is seen from the standpoint of the plaintiff.

71.7. The Courts must also be wary of the fact that the urgent interim relief must not be merely an unfounded excuse by the plaintiff to bypass the mandatory requirement of Section 12-A of the 2015 Act. 71.8. Even if the urgent interim relief ultimately comes to be denied, the suit of the plaintiff may be proceeded with without compliance with Section 12-A if the test for "urgent interim relief" is satisfied notwithstanding the actual outcome on merits."

12

2026:CHC-OS:458-DB

28. On the same aspect Novenco Building and Industry A/S (supra) is of the following view:-

"19.2. A plaintiff can be exempted from the requirement of Section 12-A only when the plaint and the documents attached with it clearly show a real need for urgent interim intervention. A wholesome reading of the plaint and the material annexed to the plaint ought to disclose the need for urgent relief.

19.3. The court must look at the plaint, pleadings and supporting documents to decide whether urgent interim relief is genuinely contemplated. The court may also look for immediacy of the peril, irreparable harm, risk of losing rights/assets, statutory timelines, perishable subject-matter, or where delay would render eventual relief ineffective.

19.4. A pro forma or anticipatory prayer for urgent relief used as a device to skip mediation will be ignored and the court can require the parties to comply with Section 12-A of the Act.

19.5. The court is not concerned with the merits of the urgent relief, but if the relief sought seems to be plausibly urgent from the standpoint of the plaintiff the court can dispense with the requirement under Section 12-A of the Act."

29. The yardstick for considering as to whether or not, the plaintiff makes out a case for dispensation under Section 12A of the Act of 2015, as culled out from the authorities noted above are as follows;

(i) pleadings in the plaint along with the documents disclosed in the plaint, are to be taken into consideration from the standpoint of the plaintiff as to 13 2026:CHC-OS:458-DB whether or not, the plaintiff requires urgent interim relief;

(ii) failure of the plaintiff ultimately to obtain an interim relief, is not, per se, fatal to the right of the plaintiff to approach the Court for dispensation under Section 12A of the Act of 2015; and

(iii) Court, however, must be cautious in order to ensure that, the prayer for urgent interim relief is not mis-utilized as a guise for dispensation of mandatory pre-institution mediation.

30. The Act of 2015 was brought came into being to ensure expeditious disposal of commercial disputes. The Act of 2015 contemplated establishment of Commercial Courts at the district level and where a High Court was with Original Jurisdiction, a Commercial Division. The appeals against the Commercial Court and the Commercial Division of the High Court would lie to the Commercial Appellate Division of a High Court.

31. The Act of 2015 delineates the commercial disputes which are to be considered by the Commercial Court or the Commercial Division. It also prescribes a Specified Value of the commercial dispute to be considered by the Commercial Court and the Commercial Division.

32. Twin test therefore, must be simultaneously satisfied for a Commercial Court or a Commercial Division to assume jurisdiction over a matter. The twin tests are that, the dispute involved in the 14 2026:CHC-OS:458-DB matter is a commercial dispute within the meaning of Section 2(1)(c) of the Act of 2015 and that, value of the subject matter of disputes conforms with the value specified under Section 7 of the Act of 2015. This assumption of jurisdiction is in addition to the parameters of jurisdiction that is laid down in the Code of Civil Procedure, 1908 for a Court to assume jurisdiction over a lis before it.

33. Section 12A of the Act of 2015 prescribes mandatory pre- institution mediation unless the plaintiff seeks urgent interim reliefs. The authorities noted herein namely, Patil Automation Private Limited (supra,) Yamini Manohar (supra), Dhanbad Fuels Private Limited (supra) and Novenco Building and Industry A/S (supra) held that, Section 12A of the Act of 2015 is mandatory.

34. In our understanding, Section 12A of the Act of 2015 specifies a pre-institution mediation in order to achieve the objective of mediation that is, preserving the existing relationship between the contractual parties to the extent possible. Mediation facilitates the existing contractual relationship to survive which a process of litigation might otherwise either destroy or at the very least disturb.

35. Section 2(1)(c) of the Act of 2015 tabulates 21 items which are commercial disputes within the meaning of the Act of 2015. Out of all the items tabulated as commercial disputes under Section 2(1)(c) of the Act of 2015, Clause (xvii) stands out in the sense that, a pre-existing commercial relationship does not exist therein. 15

2026:CHC-OS:458-DB In other words, if the plaintiff is claiming infringement or a passing off, there is no pre-existing commercial relationship between the two parties. Anxiety of preservation of a pre existing relationship, does not, per se, exist in order to require the plaintiff to undertake pre-institution mediation.

36. Novenco Building and Industry A/S (supra) noted that, an action alleging continuing infringement of intellectual property rights involves public interest. It is of the view that, in such kind of actions, urgency should be assessed in the context of the ongoing injury and the public interest in preventing deception.

37. At the same breath, we hasten to add that, simplicitor on the ground that suit is falling under Section 2(1)(c) (xvii), of the Act of 2015 the dispensation of pre institution mediation under Section 12A is not automatic. It will depend on the facts and circumstances of each case. However, the yardstick for evaluating request for dispensation under Section 12A of the Act of 2015 will be different in the case of a suit under Section 2(1)(c) (xvii) as against the other clauses of Section 2(1)(c).

38. In the facts and circumstances of the present case, the suit is composite in the sense that, it seeks relief with regard to an infringement as well as passing off. The authority cited before us namely, K. Narayanan and Another (supra) suggests that, the plaintiff cannot approach the Court merely on the basis of an application for registration unless, the plaintiff finds the offending goods in the market. In the facts and circumstances of the present 16 2026:CHC-OS:458-DB case, the appellant as the plaintiff approached the Court when, it came across products of the respondents in the market in the 2nd week of September, 2026.

39. Therefore, there are two dates which fall for consideration so far as infringement and passing off are concerned. One is January 20, 2026 when, the respondents claims that it entered the market while the appellant as the plaintiff claims that it came to learn of the products in September, 2026. This is an issue of fact which may be decided at the trial in the injunction petition. This issue of fact need not detain a Court in considering an application under Section 12A of the Act of 2015 when, the materials disclosed in the plaint along with the pleadings read from the standpoint of the plaintiff, makes out a case for dispensation under Section 12A of the Act of 2015.

40. In this regard, Novenco Building and Industry A/S (supra) is of the following view :-

> "23. The appellant's prayer for injunction cannot be characterised as mere camouflage to evade mediation. It is a real grievance founded on the continuing nature of infringement and irreparable prejudice likely to be caused by the delay. The court must look beyond time lag and evaluate the substance of the plea for interim protection. The insistence of pre-institution mediation in a situation of ongoing infringement, in effect, would render the plaintiff remediless allowing the infringer to continue to profit under the protection of procedural formality. Section 12-A of the Act was not intended to achieve such kind of anomalous result."

17

2026:CHC-OS:458-DB "25. For the reasons stated above, we hold that: (i) In actions alleging continuing infringement of intellectual property rights, urgency must be assessed in the context of the ongoing injury and the public interest in preventing deception (ii) Mere delay in institution of a suit by itself, does not negate urgency when the infringement is continuing."

41. A Special Leave Petition directed against the decision of the Co- ordinate Bench in ITC Limited (supra) granted stay thereof by the order dated November 4, 2026 passed in such Special Leave Petition being SLP (C) No. 37908 of 2026. We are bound by the ratio laid down by the Hon'ble Supreme Court in the authorities as noted above.

42. In the facts and circumstances of the present case, the infringement alleged is continuing wrong. Prevention of the ongoing injury needs consideration by the Court particularly, in view of public interest in preventing deception. The pleadings in the plaint as also documents annexed thereto, read from the stand point of the plaintiff makes out a case for dispensing with the requirement of pre institution mediation in terms of Section 12A of the Act of 2015.

43. In such circumstances, the impugned order is set aside. Appellant as the plaintiff is granted leave under Section 12A of the Act of 2015. Consequently, the plaint is admitted, subject to scrutiny. The Department will proceed on the basis of the initial suit number allotted to the plaintiff in this matter. 18

44. On the prayer made on behalf of the appellant as the plaintiff, the respondents will show cause as to why, leave under Clause 14 of the Letters Patent, 1865 will not be granted.

45. On the prayer made on behalf of the appellant as the plaintiff, leave under Order II Rule 2 of the Code of Civil Procedure, 1908 is granted.

46. TEMPAPO-IPD/7/2026 along with connected application are disposed of, without any order as to costs.

47. We clarify that, we did not enter into the merits of the rival contentions of the parties so far as the prayer for injunction is concerned. The rival contentions are kept open to be decided in the injunction petition.

(DEBANGSU BASAK, J.)

48. I agree.

(AJAY KUMAR GUPTA, J.) KB AR(CR)